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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,334	02/06/2004	Ugo Panini	730106.402	5270

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EXAMINER

PALIWAL, YOGESH

ART UNIT	PAPER NUMBER
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2112

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/774,334

Applicant(s)

PANINI, UGO

Examiner

Yogesh Paliwal

Art Unit

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/12/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08).
Paper No(s)/Mail Date 3/11/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

1. Figure 5 is objected to as depicting a block diagram without "readily identifiable" descriptors of each block, as required by 37 CFR 1.84(n). Rule 84(n) requires "labeled representations" of graphical symbols, such as blocks; and any that are "not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable." In the case of figures 5, the blocks are not readily identifiable per se. Each block should have a corresponding label that identifies its function or purpose.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin with either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

2. The information disclosure statement filed on March 11, 2005, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Following references were not considered to be an IDS complying with 37 CFR 1.98 because a legible copy was not provided. Please provide an additional copy of this document in the next correspondence:

EP 0291042 A2

EP 0461622 A2

GB 2251110 A

DE 29814558 U1

EP 1175082 A2

Claim Objections

1. The following is a quotation of 37 CFR 1.75(a):

The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

Claims 6 and 7 are objected to under 37 CFR 1.75(a), as failing to particularly point out and distinctly claim the subject matter which application regards as his invention or discovery.

Regarding **Claim 6 and 7**, both claims depend from claim 1 and mention "the casing" (in claim 6, line 3 & in claim 7 lines 3-4) which lacks antecedent basis.

Clarification is required.

Claim 2 is objected to because of the following informalities: in line 4 words "the said" are redundant. Please delete this repetition. Appropriate correction is required.

Examiner's suggestion

3. While in the preliminary amendment, applicant removed most of the drawing numerals from claims, however claim 2 still has one element ("input slot"), which is referring to the corresponding drawing numeral ("29"). Applicant is suggested to make appropriate change in the next correspondence. Examiner would like to inform the applicant that drawing numeral is not limiting the scope of the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (US2003/0009420).

Regarding **claim 1**, Jones discloses a scanner apparatus for scanning paper documents, of the type (Paragraph 0099, "document scanning system") comprising:

a first device for scanning bank checks (Paragraph 0099, "a check 1800 is placed into a scanning system..."), wherein the first device includes:

a first input receptacle for receiving at least one check to be scanned (Fig 18, Numeral 1810, Paragraph 0099, "...check 1800 is placed into a scanning system through an input receptacle 1810")

at least one first image-scanner unit for scanning at least one of the faces of the check, (Fig 18, Numeral 1840)

a first output receptacle for receiving the check after it has been scanned by the first scanner unit (Fig 18, Numeral 1830),

and a first conveyor mechanism for conveying checks, one at a time, from the first input receptacle to the first output receptacle, passing in front of the first scanner unit; (Fig 18, Numeral 1820, Paragraph 0099, "A transport mechanism...")

and the apparatus further comprising a second device for scanning other paper documents (Paragraph 0101, "the scanning system also includes a second input receptacle 815 adapted to receive invoices"), wherein the second device includes:

a second input receptacle for receiving at least one paper document to be scanned, (Fig 18, Numeral 1815)

at least one second image-scanner unit for scanning at least one of the faces of the paper document, (Fig 18, Numeral 1845)

at least one second output receptacle for receiving the paper document after it has been scanned by the second scanner unit, (Fig 18, numeral 1835)

and a second conveyor mechanism for conveying paper documents, one at a time, from the second input receptacle to the second output receptacle, passing in front of the second scanner unit. (Fig 18, Numeral 1820, Paragraph 0099, "A transport mechanism...")

Regarding **Claim 3**, Jones discloses an electronic control unit which is connected to the first image-scanner unit of the first device in order to receive signals relating to the scanning of checks from the first unit, and to the second image-scanner unit in order to receive signals relating to the scanning of the other paper documents from the second unit. (Fig. 18, Numerals 1850, 1840 and 1845),

Regarding **Claim 6**, Jones discloses the second device for scanning paper documents is housed in the lower portion of the casing and in that the first scanning device is disposed in the upper portion of the casing. (Fig. 18, Numerals 1810 and 1815)

Regarding **Claim 7**, Jones discloses the second scanning device comprises an input receptacle for paper documents, situated on a first side of the casing (Fig 18, Numeral 1815), and an output receptacle disposed on a second side of the casing opposite the first side (Fig 18, Numeral 1835).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US2003/0009420), in combination with Murakami (US 5,912,747)

Jones teaches all the elements of claim 1 as mentioned in above 102 rejection, and also teaches an outer casing containing the first scanning device and the second scanning device (Fig 18), and for the second input receptacle, the outer casing has an input slot (Fig 18, Numeral 1815)

Jones does not expressively teach the width of the input slot to be at least 210 mm.

However Murakami in the same field of endeavor of scanning devices discloses an input slot with a width of at least 210mm (Fig.1, Numeral 10, Column 9 lines 60-67, "...document D is set on...set for the A4 size original document) [It is well known in the art that the width of the standard A4 document is 210 mm].

It would have been obvious at the time the invention was made to one of ordinary skill in the art to set the width of the input slot as taught by Jones to 210 mm [Standard A4 format] as taught by Murakami because "generally, the size of an original document being used in an office is A4 size" (Column 10, lines 1-2)

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US2003/0009420), in combination with Reid-Green (US 4971309)

Jones teaches all the elements of claims 1 and 3 as mentioned in above 102 rejections, and also teaches the electronic control unit is also operatively connected to drive/actuator means of the first conveyor mechanism for picking up at least one check from the first input receptacle and conveying the check to the first output receptacle, passing in front of the first scanning unit (Paragraph 0100, "The image scanner 1840 and the transport mechanism 1820 are electronically coupled to a controller 1850"). Jones also discloses the electronic control unit is also operatively connected to drive/actuator means of the second conveyor mechanism for picking up at least one document from the second input receptacle and conveying the document to a second

output receptacle, passing in front of the second scanner unit (Paragraph 0101, "...the scanning system also includes a second input...") [Jones doesn't expressively disclose that the controller is connected to the second transport mechanism as well, but it is implied that the controller 1850 is controlling the second transport mechanism 1825 as well, because there is no other controller disclosed to control the operations of second transport mechanism].

Jones further discloses one single USB or Ethernet serial communication bus operatively connected to the electronic control unit in order to transmit to the exterior the scanning data coming from all of the scanner units of the apparatus (Fig. 12, Numerals 1260, 1230, 1275). [Jones doesn't expressively disclose the interface to be a single USB or Ethernet serial communication bus, but the scope of interface does cover both USB and Ethernet interfaces].

Jones doesn't teach the electronic control unit, which is also operatively connected to photocell means for detecting the presence of at least one check in the first and second input receptacle of the first and second scanning devices.

However, Reid-Green in the same field of endeavor of document feeding techniques discloses having a photocell means for detecting the presence of at least one check [sheet] in the input receptacle of scanning device (Column 4, lines 42-45, "A pair of photosensors 54 are mounted within alignment mechanism 32, to detect when the sheet has been inserted...") and also discloses the electronic control unit, which is also operatively connected to photocell (Column 4, lines 46-48, "...photocell signals the scanner to start...").

It would have been obvious at the time the invention was made to one of ordinary skill in the art to implement photocell detector technique as taught by Reid-Green at both of the input receptacles of Jones when photocell detect the presence of sheet, "both photocells signals the scanner to start the vacuum and then the transporter belts [Start forward movement of the sheet], so that the sheet can be taken into the scanner" (Column 4, lines 46-48). Also by having the controller control the flow, "the auto feeder system detects the presence of a sheet on the platform and does not feed another sheet until the platform is clear" (Column 4, lines 64-66).

Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US2003/0009420), in combination with Nose et al. (US 2001/0048830).

Regarding **Claim 8**, While Jones teaches all the elements of claims 1 and 7, he does not teach output receptacle situated on the first side of the casing.

However, Nose et al. in the same field of endeavor of scanning apparatus discloses output receptacle situated on the first side of the casing (Fig. 2, Numeral 7c).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to have output receptacle situated on the first side of the casing as taught by Nose et al. with the scanning system of Jones to provide easy access to the documents after the scanning process completes.

Regarding **Claim 9**, while Jones teaches all the elements of claim 1, as mentioned in above rejection, and also teaches scanner devices that scan both faces

and only one face of the document. he does not teach selectively scanning of only one face or of both faces of the document in one embodiment.

However, Nose et al. discloses a scanner in which scanning paper documents are arranged selectively to perform scanning of only one face or of both faces of the document (Paragraph 0073, "The control panel 13 shown in Fig. 1 includes the function keys 18 for selecting a scanning mode such as the one-side or both-side scanning mode...").

It would have been obvious at the time the invention was made to one of ordinary skill in the art to implement function of selecting scanning mode to scan one side or to scan both sides of the document as taught by Nose et al. in the scanner of Jones so that user would have an option to scan just one side if he doesn't want to scan both sides of the document. In the absence of such user control function, scanner would utilize more scanning functions and power to scan both sides when the user desired only one-side scanning.

Regarding **Claim 10 and 11**, the combination of Jones and Nose at al. teaches all the element of claim 1 and 9. Jones further teaches that the second image-scanner unit is mounted so as to be rotatable (Fig 5, Numeral 540) in order to be able to adopt a first angular position (Figure 5, Numeral 530) in which it is situated on one side of the path in order to scan one face of a document (Fig 5, Numeral 510) and a second angular position (Fig 5, Numeral 570) to which it is rotated from the first and in which it

is situated on the opposite side of the path (Fig 5, Numeral 540) in order to scan the opposite face of the document (Fig 5, Numeral 500c) .

The combination does not teach second conveyor mechanism comprises a pair of motor-driven rollers, which can be rotated selectively and alternatively in two opposite directions of rotation in order to move a document in one direction or in the opposite direction. Further the combination doesn't teach that the pair of motor-driven rollers is interposed between the second, rotatable scanner unit and an output receptacle for receiving the documents.

However, Nose et al. further discloses conveyor mechanism comprises a pair of motor-driven rollers, which can be rotated selectively and alternatively in two opposite directions of rotation in order to move a document in one direction or in the opposite direction (Fig 3, Numerals 26 and 27, Column 1, lines 23-28, "discharge rollers that nip an end of the original document are caused to rotate in a reverse direction"). It can be seen that both rollers are interposed between the second, rotatable scanner unit (Fig 3, Numeral 6) and an output receptacle for receiving the documents (Fig 2, 7C).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to add pair of motor-driven rollers, which can be rotated selectively and alternatively in two opposite directions of rotation as taught by Nose et al. in the scanning system of Jones "so that the document is moved backward and introduced into another paper path (second paper path) to turn the document upside down" (Column 1, lines 26-28).

Regarding **Claim 12**, combination of Jones and Nose et al., as applied in claim 10 above does not teach a deflector means which can permit the movement of a document from the second input receptacle to the second scanner unit along a first path and can deflect the document along a deflected path towards a further output receptacle when the document is moving in said opposite direction.

However, Nose et al. further discloses deflector means which can permit the movement of a document from the input receptacle to the scanner unit along a first path and can deflect the document along a deflected path towards a further output receptacle when the document is moving in said opposite direction (Fig 3, Numeral 37, column 5, lines 37-51, "The first guide member 37 can pivot up and down about a pivot center (shaft) 37a so that one of the paper paths R1 and R2 is blocked by the first guide member 37 and the paper can proceed in the other paper path"). [It can be seen that rotatable scanner unit (fig 3, Numeral 6) is interposed between the pair of motor-driven rollers (Fig 3, Numerals 26 and 27) and a deflector means (Fig 3, Numeral 37)]

It would have been obvious at the time the invention was made to one of ordinary skill in the art to further include a deflector into the combine system as taught by Jones and Nose et al so that "when a user presses certain function keys and/or other keys on the control panel to bring the machine into a one-side scanning mode, the first guide member 37 pivots downwards to a lower position A, and the document is transmitted to the first paper path R1. On the other hand, when a user selects a both-side scanning mode, the first guide member 37 pivots to an upper position B, and the document is introduced to the second paper path R2" (Column 5, lines 44-51).

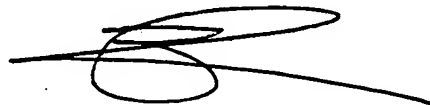
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh Paliwal whose telephone number is (571) 270-1807. The examiner can normally be reached on M-F: 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian P. Werner can be reached on (571) 272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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BRIAN WERNER
SUPERVISORY PATENT EXAMINER